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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,451	09/21/2001	Marc O. Schurr	06530.0276-00000	2507

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EXAMINER

EREZO, DARWIN P

ART UNIT PAPER NUMBER

3731

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,451

Applicant(s)

SCHURR ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 120, 121, 124, 126, 127, 129-135, 137, 138, 140, 142-157 and 164-167 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-7,120,121,124,126,127,129-135,137,138,140,142-157 and 164-167.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/22/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 124 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 124 recites the limitation "the projection" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4-7, 120, 121, 124, 126, 127,129, 131-135, 137, 138, 140, 142, 144-152; 154-157 and 164-167 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,676,676 to Porter.

As to claims 1, 2, 4- 7 and 164, Porter teaches a clip having a first arm and a second arm **12** disposed substantially opposite from each other; wherein the first and second arms define an opening capable of receiving a fold of tissue; wherein both the second and first arm includes integral anchoring portions **38** configured to maintaining a non-contacting relationship with each other of the first and second arms during a deployed state (see Figs. 6 and 7); wherein the first and second arms are configured to frictionally engage the outer surface of the tissue (once in the deployed and locked state); wherein the bottom arm shown in Fig. 1 includes a fixation hole **28** configured to receive an anchoring member **26** from the opposite arm; wherein the device further includes a gripping tab **36**; wherein the device is bioabsorbable (col. 3, line 46); wherein the arms form a substantially U-shaped configuration (Fig. 6); and wherein the device is permanently implantable.

As to claim 120, 121, 124, 126, 127,129, 131-135, 137, 138, 140, 142, 144-152, 154-157 and 165-167, Porter a clip having a first arm and a second arm **12** disposed substantially opposite from each other; wherein the first and second arms define a gap capable of receiving a fold of tissue; wherein both the second and first arm includes integral anchoring portions **38** configured to maintaining a non-contacting relationship with each other of the first and second arms during a deployed state (see Figs. 6 and 7). The clip device of Porter is fully capable of being used as a clip for treating GERD or

securing a fold of tissue. Porter also teaches the anchoring member **38** being fully capable of engaging a fold of tissue; wherein the anchoring member includes reverse angle barb (Fig. 5); wherein the anchoring portions includes two or more projections; wherein the projections are opposite of each other; wherein the distal end of the arms include a tapering portion; wherein the device further includes a gripping tab **36** at the distal end of the arms; wherein the device is bioabsorbable (col. 3, line 46); wherein the arms form a substantially U-shaped configuration (Fig. 6).

More specifically for claims 129 and 142, Porter teaches an additional anchoring member **26** that is fully capable of piercing through tissue.

More specifically for claim 148, Porter teaches the projections **38** extending only partially into the gap (Fig. 7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 130, 143 and 153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter in view of US 5,695,505 to Yoon.

Porter is silent with regard to the distal portion of the device having a tapered portion. However, Yoon teaches a similar clip, in which a distal end portion for both arms include a tapered portion (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the clip of Porter to

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include the tapered portion taught by Yoon because it would help ease the desired/target tissue into the clip opening by providing a smooth surface for the tissue to glide on.

Response to Arguments

9. Applicant's arguments with respect to all the pending but amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GLENN K. DAWOON
PRIMARY EXAMINER